

**REMARKS**

Claims 1-27 remain pending in the application. Claims 1-6, 8-17, 19 and 22-26 were rejected. More particularly, claims 1-6 were rejected under 35 U.S.C. § 102(e) as being anticipated by Fenton et al. (US 6,343,264); claims 8-15 were rejected under 35 U.S.C. § 102(e) as being anticipated by Ringland et al. (US 6,122,391); and claims 16-17, 19 and 22-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fenton (above) in view of Ring et al. (US 5,754,184). Claims 7, 18, 20-21 and 27 were objected to as depending from a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim. Applicant respectfully traverses the rejections and objections and requests reconsideration.

Applicants have amended claims 1, 8 and 23 to clarify that the decorative element is physically applied by any suitable process, such as by printing, to the window covering. This does not introduce new a requirement for new searching as claim 7 clearly recites printing, which is a physical application process, that along with other equivalent processes would have already been searched and considered by the examiner at least relative to new claim 7. Claims 7 and 10 are amended to be consistent with claim 1 and 8 as amended. The Office action objected to claims 18, 20 and 21 as being based upon a rejected base claim. These claims have been amended only to be placed in independent form. Overall, the amendments place the claim in a condition for allowance and/or in better condition for appeal, and entry of the amendments is respectfully requested.

Both Fenton and Ringland are cited under 35 U.S.C. § 102(e). Applicants do not admit that either of these references are prior art to the application. However, because

each is easily distinguished from the invention claimed in the instant application and for the sake of expediency, applicant responds substantively to the application of these references.

Fenton and Ringland are similar in what they disclose, and neither disclose, teach or suggest applicant's invention as claimed in the instant application. Fenton and Ringland teach methods and apparatus to assist a designer and/or customer of home decorating products in selecting and visualizing colors, patterns and the like. Each incorporates various processing apparatus, memory and display and visualization techniques. Neither teaches or suggests actually physically applying a chosen decorative element to a window covering at a retail location, as claim 1, 8 and 23 now clearly recite.

Applicant is clear in his disclosure that applying the decorative element to the window covering does mean physically embodying the data representing the decorative element on the window covering. Applicant does not claim a "virtual" process suggested by the references. The customer will leave the retail outlet with actual, physical window coverings having a chosen decorative element applied thereto. Applicant discloses at least printing (see paragraph 23 of the specification), laminating (see paragraph 35 of the specification) and texturing (see paragraph 35 of the specification) as techniques for "applying" the decorative element to the window covering.

For these reasons, applicant submits the claims are neither anticipated by nor rendered obvious in view of either Fenton or Ringland.

As for the rejection of claims 16-17, 19 and 22-26 as being unpatentable over Fenton in view of Ring, applicant traverses this rejection. As noted, Fenton at least fails to teach or suggest the claimed step of physically applying the decorative element to the

window covering at the retail outlet. Regardless of what else Ring may teach, and applicant does not address specifically what Ring may in fact teach, Ring fails also to teach or suggest the step of applying the decorative element to the window covering at the retail outlet. As such, these claims are not rendered obvious by Fenton in view of Ring.

Applicant believes the application as a whole is in a condition for allowance and such action is requested that the examiner's earliest convenience. The examiner is encouraged to contact applicant's undersigned attorney with any questions regarding this response or the application as a whole.

The Director is authorized to charge any deficiency in the amount enclosed or any additional fees which may be required to Deposit Account No. 13-2855.

Dated: November 16, 2004

Respectfully submitted,

By 

Anthony G. Sitko

Registration No.: 36,278

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive, Suite 6300

Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Applicant